

GUSTAV HAGEN ET AL.
USSN 09/424,686

underlining is attached.

An additional objection was made to the absence of more text on pages 20 and 44. In response, Applicants point out that these pages both constitute the ends of their respective sections. Accordingly, no informality is seen in having these pages end where the section ends. Moreover, it is unclear how the Examiner would have Applicants correct the lack of more text on these pages.

Claims 1-5, 7, 10, 11 and 13 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have replaced the previous claims by a new set of claims which Applicants believe clearly overcomes each of the Examiner's concerns.

Claims 1-5, 7, 10, 11 and 13 were rejected under 35 USC § 112, first paragraph, as being broader than the enabling disclosure. In response, Applicants point out that the claims have been limited to the species which the Examiner indicated were enabled.

Claims 1-5, 7, 10, 11 and 13 were rejected under 35 USC § 102(e) as being anticipated by Cech et al. ("Cech"), U.S. Patent No. 6,166,178. In response, Applicants do not believe that the Examiner has made out a *prima facie* case of anticipation. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

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As Applicants have a statutory right to a patent unless some statutory defect is raised, the burden is squarely on the Examiner in the first instance to make out a *prima facie* case that a statutory defect exists. In the present case, the Examiner points out that Cech "issued Dec. 26, 2000, with a priority date Oct. 1, 1996." Applicants submit that this is inadequate on its face to establish Cech as prior art under § 102(e), and, therefore, to discharge the Examiner's burden of making out a *prima facie* case of anticipation.

As is clearly stated in MPEP § 2136.03(TV), the "filing date of U.S. parent application can only be used as the 35 U.S.C. 102(e) date if it supports the claims of the issued child." Applicants point out that chain going from the application that issued as Cech's patent back to the ultimate parent that claims priority of October 1, 1996, contains nothing but continuations-in-part. This means that benefit of Cech's parent applications is not automatically granted. Instead, it was incumbent upon the Examiner to review each of Cech's parent applications to establish whether the filing dates thereof were properly utilized under 35 USC § 102(e). Further, a *prima facie* case of anticipation required that the Examiner include the results of such review as a part of her statement of the rejection. Since the results of the review were not included, Applicants submit that the Examiner has not made out a *prima facie* case of anticipation. Accordingly, Applicants respectfully submit that this rejection should be reconsidered and withdrawn.

Applicants would also point out that new claims 14-43 are all directed to specific

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sequences. Accordingly, anticipation requires that those species be described exactly in Czech.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By _____

Kurt G. Briscoe
Reg. No. 33,141

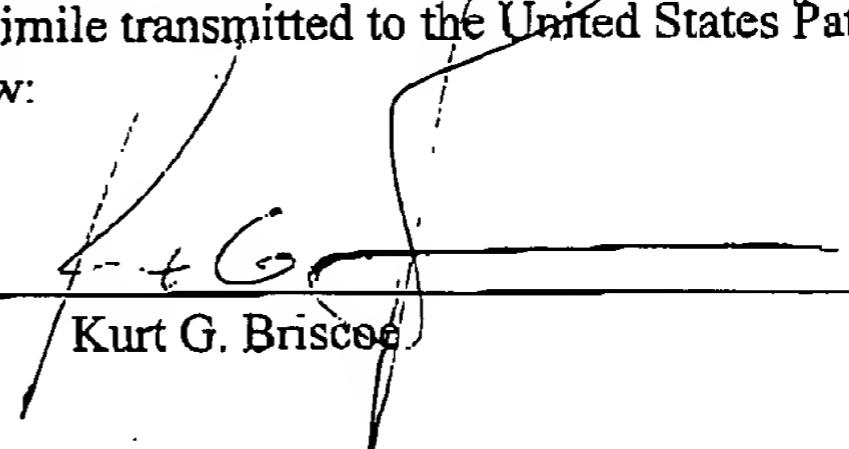
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.11 and the attached Mark-Up Showing the Changes Made in the Specification and the accompanying Petition for Extension of Time (16 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: February 15, 2002

By 
Kurt G. Briscoe

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MARK-UP SHOWING THE CHANGES MADE IN THE SPECIFICATION

Page 9, first paragraph:

A DNA sequence, or a degenerate variation of this sequence, which encodes the phTC protein, or a fragment of this protein, where appropriate comprising the DNA sequence in Figure [1a] 1, or a DNA sequence which hybridizes with the previously cited DNA sequence under standard hybridization conditions.

Page 9, second paragraph:

A recombinant DNA molecule which comprises a DNA sequence, or a degenerate variation of this sequence, which encodes phTC or a fragment of phTC, with the latter sequence preferably comprising the DNA sequence in Figure [1a] 1, or which comprises a DNA sequence which hybridizes with the previously cited DNA sequence under standard hybridization conditions.

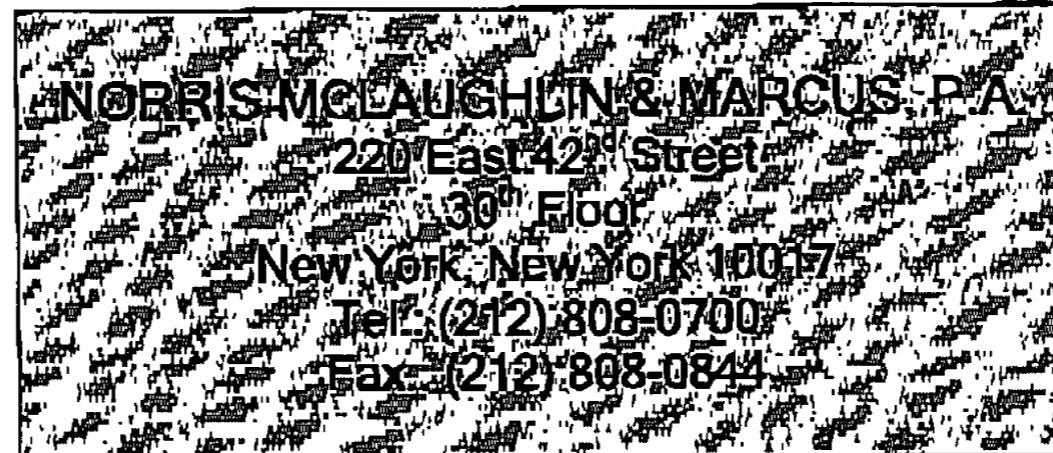
Page 10, next-to-last paragraph:

Particular preference is also given to the exogenous polynucleotide being able to comprise the sequence in Figure [1a] 1.

FACSIMILE COVER SHEET**FAX RECEIVED**

AUG 19 2002

GROUP 1600



703 305 3014

Comments:

Enclosed: Response, and petition for extension of time dated, 2/15/02 with PTO Fax Auto-Reply confirmation sheet.

You should receive 17 pages including this cover sheet.

Very truly yours,

Theodore Gottlieb, Ph.D.

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